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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,837	12/11/2003	Herman Rodriguez	AUS920030906US1(4028)	2209
45557 7590 06/05/2009 IBM CORPORATION (JSS) C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER				
OYEBISI, OJO O				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,837

Applicant(s)

RODRIGUEZ ET AL.

Examiner

OJO O. OYEBISI

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 12/03/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to the restriction requirement mailed on 02/30/09, the following have occurred: The applicant has elected the invention of Group I (claims 1-29) without traverse, and has withdrawn independent claim 30 from consideration. The applicant has also added a new dependent claim 30. Applicant's election of claims 1-29 is hereby acknowledged.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-8, 17-22, 23-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller et al (Goeller hereinafter, US PUB No.: 2002/0178112) in view of Drummond et al (Drummond hereinafter, US PUB NO.: 20030217005).
Re claim 1. Goeller discloses a method for generating an e-check, the method comprising: scanning a check to create an image of the check in response to receiving

a check as payment for a transaction (i.e., check can be entered at the point of sale using a scanner, OCR equipment etc, see paras 0115); entering an amount of currency represented by the check into a point of sale terminal (see fig.5 element 302, also see paras 0039); identifying check information that describes a bank and a bank account (see paras 0039), wherein the check comprises the check information (see paras 0039, see fig.4-5). Goeller does not explicitly disclose generating a negotiable instrument, wherein the negotiable instruments comprises a check object based upon the image, the amount, and the check information, wherein the check object includes the image (see Goeller paras 0054). However, a secondary reference, Drummond, explicitly discloses generating a negotiable instrument, wherein the negotiable instruments comprises a check object based upon the image, the amount, and the check information, wherein the check object includes the image (see Drummond paras 0262). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.

Re claim 2. Goeller further discloses the method of claim 1, further comprising printing the amount on the check (see the abstract).

Re claim 3. Goeller further discloses the method of claim 1, wherein scanning the check comprises scanning the check at the point of sale terminal (see paras 0054).

Re claim 4. Goeller further discloses the method of claim 1, wherein entering the amount comprises communicating the amount represented by the check to the point of sale terminal (see fig.5 element 302, also see paras 0039).

Re claim 5. Goeller further discloses the method of claim 1, wherein identifying the

check information comprises determining a routing number, an account number, and a check number (see paras 0039).

Re claims 6, 7. Goeller does not explicitly disclose, wherein generating the check object comprises creating the check object with at least the image, the routing number, the account number, and the amount. However, a secondary reference, Drummond explicitly discloses, wherein generating the check object comprises creating the check object with at least the image, the routing number, the account number, and the amount (see paras 0262). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.

Re claim 8. Goeller further discloses the method of claim 1, wherein identifying the check information comprises implementing magnetic ink character recognition to read the check information from the check (see paras 0039).

Re claim 17. Goeller further discloses an apparatus for generating an e-check, the apparatus comprising: an image scanner to create an image of a check in response to receiving the check as payment for a transaction ((i.e., check can be entered at the point of sale using a scanner, OCR equipment etc, see paras 0115); an input device to input an amount of currency represented by the check (see fig.5 element 302, also see paras 0039); a character scanner to scan the check to identify check information that describes a bank and a bank account (see paras 0039, 0054 and 0115). Goeller does not explicitly disclose an e-check generator to generate a negotiable instrument, wherein the negotiable instruments comprises a check object based upon the image,

the amount, and the check information, wherein the check object includes the image. However, a secondary reference, Drummond, explicitly discloses e-check generator to generate a negotiable object, wherein the negotiable instruments comprises a check object based upon the image, the amount, and the check information, wherein the check object includes the image (see Drummond paras 0262). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.

Re claim 18. Goeller further discloses the apparatus of claim 17, further comprising a printer to print the amount on the check as a receipt for the customer (see paras 0049)

Re claim 19. Goeller further discloses the apparatus of claim 17, wherein the image scanner is adapted to scan the check at a point of sale (see paras 0115)

Re claim 20. Goeller further discloses the apparatus of claim 17, wherein the input device comprises a keypad to type the amount represented by the check (see fig.1 element 108).

Re claim 21. Goeller further discloses the apparatus of claim 17, wherein the character scanner comprises magnetic ink character recognition to determine a routing number associated with the bank, an account number associated with the bank account, and a check number associated with the check (i.e., OCR device, see fig.1 element 112).

Re claim 22. Goeller does not explicitly disclose the apparatus of claim 17, wherein the e-check generator is adapted to create the check object with at least the image, the routing number, the account number, and the amount. However, Drummond discloses wherein the e-check generator is adapted to create the check object with at least the

image, the routing number, the account number, and the amount (see paras 0262).

Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.

Re claim 23. Goeller further discloses a machine-accessible medium containing instructions, which when executed by a machine, cause said machine to perform operations, comprising: scanning a check to create an image of the check in response to receiving a check as payment for a transaction (i.e., check can be entered at the point of sale using a scanner, OCR equipment etc, see paras 0115); entering an amount of currency represented by the check into a point of sale terminal (see fig.5 element 302, also see paras 0039); identifying check information that describes a bank and a bank account, wherein the check comprises the check information (see paras 0039, 0054 and 0115). Goeller does not explicitly disclose generating a negotiable instrument, wherein the negotiable instruments comprises a check object based upon the image, the amount, and the check information, wherein the check object includes the image (see Goeller paras 0054). However, a secondary reference, Drummond, explicitly discloses a negotiable instrument, wherein the negotiable instruments comprises a check object based upon the image, the amount, and the check information, wherein the check object includes the image (see Drummond paras 0262).

Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.

Re claim 24. Goeller further discloses the machine-accessible medium of claim 23 wherein the operations further comprise printing the amount on the check (see the

abstract).

Re claim 25. Goeller further discloses the machine-accessible medium of claim 23, wherein scanning the check comprises scanning the check at a point of sale terminal (see paras 0054 and 0115).

Re claim 26. Goeller further discloses the machine-accessible medium of claim 23, wherein entering the amount on the check comprises communicating the amount represented by the check to the point of sale terminal (see fig.5 element 302, also see paras 0039).

Re claim 27. Goeller further discloses the machine-accessible medium of claim 23, wherein identifying the check information comprises determining a routing number, an account number, and a check number (see paras 0039).

Re claim 28. Goeller does not explicitly disclose the machine-accessible medium of claim 27, wherein generating the check object comprises creating the check object with at least the image, the routing number, the account number, and the amount. However, a secondary reference, Drummond explicitly discloses, wherein generating the check object comprises creating the check object with at least the image, the routing number, the account number, and the amount (see paras 0262). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.

Re claim 29. Goeller further discloses the machine-accessible medium of claim 23, wherein identifying the check information comprises implementing magnetic ink character recognition to read the check information (see fig.1 element 112).

Re claim 31. Goeller discloses the method of claim 1, further comprising receiving, via the point of sale terminal, a personal identification number (PIN) and a driver license number (i.e., identification data, see the abstract); wherein the scanning comprises scanning at the point of sale terminal (see paras 0115); wherein further the identifying check information comprises reading, via a magnetic ink character recognition (MICR) system (see fig.1 element, 110), a routing number, the bank account, and a check number; wherein the check object that includes the routing number, the account number, the check number, and an e-check identification number (see fig.5); wherein further the e-check identification number is to distinguish the e- check from other e-checks. Goeller does not explicitly disclose wherein the image of the check is in a Joint Photographic Experts Group (JPEG) format. However, JPEG is a commonly used method of compression for photographic images. Thus, it would have been obvious to one of ordinary skill in the art to generate the scanned image, as taught by Goeller, utilizing the commonly used JPEG image format to provide high resolution image.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Goeller.

Re claim 9. Goeller discloses a method for transacting with an e-check, the method comprising: generating the e-check based upon an image of a check (i.e., check can be entered at the point of sale using a scanner, OCR equipment etc, see paras 0115) to substitute for a check as payment for a transaction; wherein the e-check includes the image; transmitting the e-check to a bank wherein the bank is identified by a routing number on the check (see fig.6A, element 410); and receiving a response to transmission of the e-check from the bank (see fig.6b ELEMENT 474), the response to clear the check when sufficient funds are available for the transaction from an account associated with the e-check (see fig.6Belement 462, and 470).

Re claim 10. Goeller further discloses the method of claim 9, wherein generating the e-check comprises generating the e-check at the point of sale terminal (i.e., check can be entered at the point of sale using a scanner, OCR equipment etc, see paras 0115)

Re claims 11, 12-13. Goeller further discloses the method of claim 9, wherein transmitting the e-check comprises identifying an electronic address using the routing number (see fig.6A, element 410).

Re claim 14. Goeller further discloses the method of claim 9, wherein transmitting the e-check comprises transmitting a request to transfer an amount associated with the e-check to an account associated with a merchant (see fig.6A, element 410)

Re claim 15. Goeller further discloses the method of claim 14, wherein receiving the response comprises receiving an indication that the amount is credited to the account associated with the merchant (see fig.6b ELEMENT 474)

Re claim 16. Goeller further discloses the method of claim 14, wherein receiving the response comprises receiving a denial for the request to transfer the amount (see fig.6b ELEMENT 478).

Response to Arguments

Applicant's arguments filed on 11/10/08 have been fully considered but they are not persuasive. The applicant argues in substance that the prior art of records fail to disclose scanning a check to create an image of the check in response to receiving a check as payment for a transaction. Contrary to the applicant's assertion, Goeller teaches that check can be entered at the point of sale using a scanner, OCR equipment etc, (see paras 0115). The examiner contends that when a check is scanned what is created is the image of the check.

The applicant further argues that prior arts of record fail to disclose generating a negotiable instrument that comprises a check object which is based .upon the image. Contrary to the applicant's assertion, the secondary reference Drummond explicitly discloses generating a negotiable instrument that comprises a check object which is based .upon the image, especially generating the check object for the purpose of the object with the image taking the place of the check as the negotiable instrument (i.e., In exemplary embodiments at least one digital image of a check received for deposit is generated at the automated banking machine. As previously discussed, a check scanner or other imaging device may be used to capture the image. The check image may be forwarded or otherwise made accessible to a remote computer, such as the host bank. A data store in operative connection with the remote computer may store a

copy of the imaged check or selected portion(s) thereof, and possibly other information associated therewith. The other information may include information enabling a bank to have proper record keeping and retrieval of the check image, such as the checking account, check number, payor, payee, date, time, amount, etc. The remote computer may be used to produce copies of the check image either electronic or hard copy as may be requested. The remote computer or other computer connected to the data store can be used to e-mail an image of the check to the e-mail address associated with the account listed on the check as associated with the payor. Alternatively the remote computer may resolve an address associated with the maker or payor and/or other entity who is to receive an image corresponding to the check, and may operate to cause the controller in the machine to forward the image or to make the image data stored at the machine accessible to such system address. Image data corresponding to the check can be electronically sent or made accessible to financial institutions, clearing houses or other entities which may require knowledge of the information associated with the check and/or one or more images thereof. For example the check image may be electronically sent to the bank on which the funds are withdrawn, the Federal Reserve, other government agencies, outsourcing facilities, and/or other organizations. The check image may also be sent or made accessible to law enforcement agencies. Of course the host can also print a hard paper copy of the check and mail the paper copy to a financial institution or to the customer, see paras 0268 of Drummond). The examiner contends that a check is a negotiable instrument. A negotiable instrument is a

transferable, signed document that promises to pay the bearer a sum of money at a future date or on demand. Examples include checks, bills of exchange, and promissory notes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Primary Examiner, Art Unit 3696